

Appl. No. 10/665,984  
Amdt. dated February 16, 2006  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group 2876

PATENT

**REMARKS/ARGUMENTS**

Independent claims 12, 36, and 67 have been amended. Claims 1-9, 11-12, 15-20, 23-31, 33-36, 41-50, 67 and 74-78 are pending. Reconsideration of the claims is respectfully requested.

Claims 12, 15-20, 31, 33-34, 36, 41-42, 45-50, 67, 74, and 76-78 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0182940 in the name of Biller. Claims 1-9, 11, 43-44, and 75 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Biller in view of Japanese Publication No. 2001/109859 in the name of Motoe. Claims 23-30 and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication 2002/0006103 in the name of Duroj in view of Biller. Such rejections are traversed in part and overcome in part as follows.

As the Examiner certainly knows and appreciates, *prima facie* obviousness requires that the prior art references, alone or in combination, teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). In the instant case, several of the claimed limitations, as discussed below, have not been reasonably disclosed or suggested by any of the cited references. Secondly, no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner for the proposed modifications of the reference teachings so as to produce the claimed inventions. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

In order to expedite prosecution of the present case, **independent claim 12** has been amended so that it now recites, in part, a data card comprising a rectangular shape with a front and a back side, a top and a bottom flat portion each about 3 3/8 inches long, and two side flat portions each about 2 1/8 inches long, a J-peg shaped aperture located on one of the two side portions of the data card, and a live copy limit is located on the front or back side of the card at about 3/32 of an inch from the top, bottom, and both side portions of the data card.

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First, the Biller reference fails to teach or suggest a rectangular shaped data card having four flat portions, much less the specific card dimensions and live copy limits recited in claim 12. Biller is limited to a media disc having a circular shape, which may include a rectangular portion clearly having less than four flat portions. Further, the Examiner appears to agree that Biller does not teach the claimed dimensions of the card, nor the claimed live copy limits. Office Action, pages 3-4.

Second, based on the Biller reference, one of ordinary skill in the art would not have been reasonably motivated to modify this teaching so as to produce Applicants' claimed data card. The Examiner however attempts to cure these deficiencies by stating that it would have been obvious to an artisan of ordinary skill in the art at the time of the invention was made to incorporate the known standard credit card size with CR80 type in the teachings of Biller. With respect to the live copy limitations, the Examiner states that it would have been an obvious modification of the layout format of the printed formation of the card. Office Action, pages 3-4. Applicants respectfully disagree.

Applicants point out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in the Biller reference which teaches or suggest its modification. As noted above, Biller makes no mention of any rectangular shaped data cards having four flat portions, let alone any card dimensions, live copy limits, or CR80 standards. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach a conclusion based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings). The Examiner is further reminded that hindsight reconstruction based on Applicants disclosure is impermissible.

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Advantageously, the present invention provides a J-peg shaped aperture on a data card comprising a rectangular shape with a top and a bottom flat portion each about 3 3/8 inches long and two side flat portions each about 2 1/8 inches long so that it may be easily carried in a user's wallet. The live copy limit is located on the front or back side of the card at about 3/32 of an inch from the top, bottom, and both side portions of the data card so as to prevent cropping of any copy and/or critical graphics. For the several reasons discussed above, Applicants respectfully request withdrawal of this rejection and allowance of independent claim 12 (and the claims which depend therefrom).

**Independent claim 31** recites in part a data card having a circular shaped portion and a rectangular shaped bottom portion. In particular, the rectangular shaped bottom portion has the information storage medium displayed thereon and the diameter of the circular shaped portion is less than a longest length of the rectangular shaped bottom portion. This limitation has neither been shown or suggested in the Biller reference. In contrast, Biller is limited to a media disc having a circular shape, which may include a rectangular portion where the diameter of the circular portion is clearly greater than the length of the rectangular portion. With respect to Examiner's citation of Fig. 7 in Biller, Applicants point out that the circular disc 20 is affixed to a separate component, namely a carrier 100. Biller, paragraph 42. The removable portion of the carrier 120 holds the magnetic strip 70. This two part structure is clearly distinct from the claimed data card structure. As such, Applicants respectfully request withdrawal of this rejection and allowance of independent claim 31 (and the claims which depend therefrom).

**Independent claim 36** has been amended to recite similar limitations as those argued above with respect to independent claim 12. As such, claim 36 should be allowable for the same reasons. Further, claim 36 requires that the aperture be at least 1/16 of an inch from the live copy limit and the information storage medium. This limitation advantageously prevents against cropping of copy, critical graphics, or of the magnetic stripe or bar code. Again, this limitation is nowhere taught or suggested in the Biller reference. For this additional reason, independent claim 31 (and the claims which depend therefrom) should be allowable.

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**Independent claim 67** has been amended to recite similar limitations as those argued above with respect to independent claim 12. As such, claim 67 should be allowable for the same reasons. Further, claim 67 requires a protrusion extending no more than about 1/2 of an inch and at least 1/8 of an inch away from the top edge. Again, this limitation is nowhere taught or suggested in the Biller reference. For this additional reason, independent claim 67 (and the claims which depend therefrom) should be allowable.

**Independent claim 1** recites in part a data card comprising a rectangular shape having dimensions that are about 2 1/8 inches by about 3 3/8 inches, wherein the live copy limit is within about 3/32 of an inch from the outside edge of the card, and wherein each aperture is at least about 1/16 of an inch from each other, the live copy limit, and the information storage medium. As discussed above, Biller does not teach or suggest any of these claimed limitations. Motoe discloses a card with a plurality of holes for suspending the card from a binder, but does not teach or suggest a data card with the specific card dimensions, live copy limits, nor apertures at least 1/16 of an inch from each other, the live copy limit, and the information storage medium as required by claim 1. Applicants request, if the present rejection is maintained, that the Examiner show or explain where the Biller and/or Motoe references provide the requisite motivation to modify the teachings so as to produce Applicants' claimed invention. Absent such a showing, Applicants respectfully request withdrawal of this rejection and allowance of independent claim 1 (and the claims dependent thereon).

**Independent claim 23** recites in part a data card having a live copy limit that is about 3/32 of an inch from the outside edge of the card and an aperture that is at least 1/16 of an inch from the live copy limit and the information storage medium. As discussed above, Biller does not teach or suggest these feature. Duroj discloses a rectangular storage card for use with a CD or DVD player. However, Duroj does not teach or suggest a data card with a front side comprising a live copy limit that is 3/32 of inch from the outside edge of the card and apertures at least 1/16 of an inch from the live copy limit and the information storage medium as claimed. Applicants request, if the present rejection is maintained, that the Examiner show or explain where the Biller and/or Duroj references provide the requisite motivation to modify the teachings

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so as to produce Applicants' claimed invention. Absent such a showing, Applicants respectfully request withdrawal of this rejection and allowance of independent claim 23 (and the claims dependent thereon).

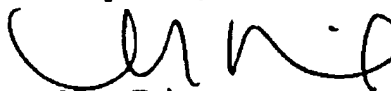
**Independent claim 35** recites similar limitations as those argued above with respect to independent claim 23. As such, claim 35 should be allowable for the same reasons. Further, claim 35 requires a rectangular shaped aperture. Biller and Duroj also fail to teach or suggest this feature. For this additional reason, independent claim 35 should be allowable.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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